

Appl. No. 10/538,207  
 Amendment and/or Response  
 Reply to Office action of 15 December 2006

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REMARKS / DISCUSSION OF ISSUES

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Claims 1-32 are pending in the application.

The applicants thank the Examiner for acknowledging the claim for priority and receipt of certified copies of all the priority documents, and for determining that the drawings are acceptable.

The Office action rejects claims 1-32 under 35 U.S.C. 102(e) over Harrington (USPA 2002/0156909). The applicants respectfully traverse this rejection.

Claim 1, upon which claims 2-6 depend, claims a system that includes a portable wireless device having a media drive and an application that reads and plays back content from a medium inserted in the media drive, and a service that communicates with the wireless device via a wireless network, the service providing control commands to the application program for controlling playback of content from the medium when inserted in the media drive.

The Examiner's attention is requested to MPEP 2131, wherein it is stated:

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Also, the Board of Patent Appeals and Interferences has consistently upheld the principle that the burden of establishing a prima facie case resides with the Office, and to meet this burden, the Examiner must specifically identify where each of the claimed elements are found in the prior art:

"there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). To meet [the] burden of establishing a prima facie case of anticipation, the examiner must explain how the rejected claims are anticipated by pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection." *Ex Parte Naoya Isoda*, Appeal No. 2005-2289, Application 10/064,508 (BPAI Opinion October 2005).

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The Office action fails to show where Harrington teaches a portable wireless device having a media drive.

The Office action fails to show where Harrington teaches an application that reads and plays back content from a medium inserted in a media drive of a portable wireless device.

The Office action fails to show where Harrington teaches a service that provides control commands to an application program for controlling playback of content from a medium when inserted in a media drive of a portable wireless device.

The Office action cites Harrington for teaching "a system and method for relating Temporal Signals (which appear, for example, on a television broadcast, a VHS or Beta tape, CD-ROM, DVD, CD, memory stick or other medium) (Page 2 paragraph [0014]) wherein such a system and method is implemented on a wireless device and wireless communication devices (Page 3, paragraph [0016])... and a system and method which provides server-side control of a Flash movie playing on a client device (Page 2, paragraph [0015]))" (Office action, page 3, lines 5-13). While these cites may provide the asserted teachings, the applicants respectfully note that these teachings do not address a media drive on a portable device, nor an application that controls such a media drive, nor a service that controls the playback of content from medium inserted in such a media drive.

As noted in the Office action, Harrington teaches a system and method for providing server-side control of a portable device that includes a Flash player. As is known in the art, and as taught by Harrington, a Flash player is a software program, not a "media drive". The Office action fails to identify where Harrington teaches that the wireless device that includes a Flash player also includes a media drive, fails to identify where Harrington teaches playing back content from a medium inserted in such a media drive, and fails to identify where Harrington teaches controlling such a media drive from a server.

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Because the Office action fails to identify where Harrington teaches each of the elements of claim 1, the applicants respectfully maintain that the rejection of claims 1-6 under 35 U.S.C. 102(e) over Harrington is unfounded, per MPEP 2131.

In like manner:

claim 7, upon which claims 8-14 depend, claims a portable wireless device that includes a media drive and an application that plays back content from a medium when inserted in the media drive, the application playing back content from the medium based upon control commands received from a service via a wireless network;

claim 15, upon which claims 16-25 depend, claims a service that includes generating and transmitting control commands via a network to a portable wireless device, the control commands controlling playback of content of a medium inserted in a media drive of the wireless device; and

claim 26, upon which claims 27-32 depend, claims a medium that is insertable into a media drive of a portable wireless device, and readable for playback of content by an application stored in the wireless device when control commands are received by the application from a remote service.

As noted above, the Office action fails to identify where Harrington teaches a portable wireless device with a media player, and fails to teach controlling the playback of a medium that is inserted in the media player via commands from a remote server. Therefore, the applicants respectfully maintain that the rejection of claims 7-32 under 35 U.S.C. 102(e) over Harrington is unfounded, per MPEP 2131.

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In view of the foregoing, the applicants respectfully request that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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